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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,182	07/13/2005	Kyoung-Min Shin	F-8709	7833

28107 7590 11/28/2006  
JORDAN AND HAMBURG LLP  
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NEW YORK, NY 10168

EXAMINER

NEAL, TIMOTHY J

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/542,182

**Applicant(s)**

SHIN ET AL.

**Examiner**

Timothy J. Neal

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

This action is in response to applicant's amendment received on 10/30/2006.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claim 1** is rejected under 35 U.S.C. 102(a) as being anticipated by Yim et al. (KR 20-0314211).

Yim et al. discloses a self-expandable stent, comprising: a coated primary unit having a hollow cylindrical body fabricated by knitting a shape-memory alloy wire to make a net structure having a plurality of diamond-shaped meshes (Fig. 3 Item 5), with both an enlarged diameter part formed at each end of the body (Fig. 3 at the both ends) and a coat layer formed on an external surface of the primary unit to externally cover a sidewall of the unit (Fig. 3 and Fig. 4 Item 10); and an uncoated secondary unit being fixed to and surrounding the hollow cylindrical body of the coated primary unit (Fig. 3 Item 15 and Paragraph 3 of Configuration and Action of the Invention), the secondary unit being disposed between each end of the primary unit (Fig 3); the secondary unit having a hollow cylindrical body fabricated by knitting a superelastic shape-memory alloy wire to make a net structure having a plurality of diamond-shaped meshes (Fig. 3

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Item 11), wherein the stent is prevented from being undesirably removed from a narrow or blocked target portion of the gullet having a lesion.

### ***Response to Arguments***

Applicant's arguments, see Page 1 Paragraph 2, filed 10/30/2006, with respect to claim 1 have been fully considered and are persuasive. The U.S.C. 103 rejection of claim 1 has been withdrawn due to amendment.

Applicant's arguments with respect to the U.S.C. 102 rejection of claim 1 have been considered but are moot in view of the new ground(s) of rejection.

The Yim reference discloses the invention as claimed as presented above. The Applicant has stated that the Yim reference discloses the secondary unit being removed by means of a wire after cauterization. The Examiner has determined that this is not the case. The reference states that the wire is removed after cauterization, but not the secondary unit. The Examiner points to paragraphs 15 and 16 of the Configuration and Action of the Invention portion of the reference. The translation obtained by the Examiner begins the aforementioned paragraph with "Since the wire (31) connected with said conductive body..." and ends the following paragraph with "...the space part (3) of the body (5)." These paragraphs disclose the action of the invention and the removal of the wire. The paragraphs also describe that after cauterization and removal of the wire, the dual structure of the stent is still intact and within the body. Also, throughout the disclosure, there are references to the secondary unit being connected

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to the primary unit. Therefore, even if the Applicant considers the secondary unit to be removed with the wire, the Examiner considers the reference to include a secondary unit fixed to the primary unit. The entire device enters into the body as one entity with the units attached to each other. This sufficiently anticipates the claim.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Neal whose telephone number is (571) 272-0625. The examiner can normally be reached on M-F 9:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TJN

  
ANH TUAN T. NGUYEN  
SUPERVISORY PATENT EXAMINER

4/20/06